

United States  
Circuit Court of Appeals

For the Ninth Circuit 12

SAMUEL EAGLE, JOHN WILLIAM LANGS,  
and PLOMB TOOL COMPANY, a corporation,  
*Appellants,*

*vs.*

P. & C. HAND FORGED TOOL COMPANY,  
a corporation,  
*Appellee.*

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**Appellants' Brief**

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Upon Appeal from the United States District Court  
for the District of Oregon

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**FILED**

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**Appellants' Brief**

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Appeal from the United States District Court for the  
District of Oregon.

HONORABLE JAMES ALGER FEE, District Judge

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**THE ISSUES**

**Statement of the Case**

This is an appeal from a decree adjudging invalid and void for lack of invention the single claim of the patent granted to Samuel Eagle, patented June 7, 1921, No. 1,380,643, for an improvement in wrenches.

The respective plaintiff-appellants are the inventor, Samuel Eagle, an assignee of an interest John William Langs, and Plomb Tool Company, a corporation, licensee under said patent.

By stipulation entered into between the parties, Plaintiffs' Exhibit 1 (T. 156-7), the corporate status of the Plaintiff Plomb Tool Company stands admitted instead of denied, and the interests of the various parties are evidenced by the exhibition of the patent and instruments of conveyance thereof.

The Appellee P & C Hand Forged Tool Company, a corporation, admits due and legal notice of infringement of said Eagle patent. Evidence was admitted proving the receipt of a circular, Plaintiffs' Exhibit 7, (T. 125) in 1922, **some three years before Appellee commenced the actual manufacture of their infringing wrenches** and of letters addressed to Appellee by Appellants' attorney, which letters it acknowledged (T. 150-1).

Infringement of the single patent claim is conceded by Appellee, said confession being summarized in Appellee's brief filed in the United States District Court for the District of Oregon as follows:

"The issue in this case is simple. The wrenches manufactured and sold by the Defendant—referring to both Defendant's Interrogatory Exhibits A and A' and B and B'—are in substance the same as the Eagle patent. There is thus only one question involved; name-

ly, does the structure defined in said claim involve invention?"

### The Patented Wrench

The Eagle wrench has been termed in the trade a flex-handle or hinge-handle wrench and comprises a handle to one end of which is secured a short socket support having its free end squared. Said socket support is pivotally mounted upon a pin permitting the socket support angular movement in a single plane. Slidably secured to the squared end of said socket support is a standard socket. A spring pressed pin bears against the pivoted end of the socket support to hold the latter in different positions. A standard socket is a hollow shell having a non-circular bore, one end of said bore being squared to fit said socket support and the other formed to fit a nut to be turned by said wrench (T. 103). This structure is clearly shown in the drawings which form a part of the Eagle patent. Plaintiffs' Exhibit 2, (T. 33-36). The purpose of said wrench and its function are set out in the introduction of said patent, lines 7 to 19 inclusive, as follows:

"The invention relates to improvements in wrenches and particularly to socket wrenches and the principal object of the invention is to provide a simply constructed and inexpensive and durable wrench which can be easily and quickly attached to the usual socket

and is arranged so that the handle can be brought to a position axially alined with the socket or swung sidewise as occasion demands.

A further object is to arrange the wrench so that the handle can be releasably locked in its axial position."

The manner in which said wrench is used is diagrammatically shown in Plaintiffs' Exhibit 7 (T. 125), and its features are described in said exhibit as follows:

"This wrench has all the advantages of a ratchet combined with a simplicity all its own. It can be used in the most awkward places; it fits and reaches any and all nuts and bolt heads. When working at a bolt or nut which permits only half a turn, the hinged handle of the wrench can be brought through the half turn, then swung over to the original position and the full circle completed. When it is impossible to get a half turn, the handle stands straight away from the end of the socket and is turned by means of a punch through the holes provided, doing away with the annoyance always encountered in a job of this sort."

### **Prior Art**

Appellee has cited as examples of the prior art all of the patents cited by the Patent Office in considering the application for patent which



matured into the Eagle patent. These references are as follows:

United States Patent No. 348,565, issued to I. J. Mandeville, dated Sept. 7, 1886, entitled Combination Tool, identified as Defendant's Exhibit "C" (T. 49);

United States Patent No. 1,168,204, issued to J. Helstrom, dated Jan. 11, 1916, entitled Wrench, identified as Defendant's Exhibit "F" (T. 65);

United States Patent No. 1,169,987, issued to E. R. Miottel, dated Feb. 1, 1916, entitled Socket Wrench, identified as Defendant's Exhibit "G" (T. 71);

United States Patent No. 1,209,658, issued to O. F. Baltzley, dated Dec. 26, 1916, entitled Tool, identified as Defendant's Exhibit "I" (T. 79);

In addition, Appellee cites and relies upon the following patents:

United States Patent No. 820,185, issued to John W. Edmands, dated May 8, 1906, entitled Tool, identified as Defendant's Exhibit "D" (T. 53);

United States Patent No. 1,292,285, issued to Mortimer J. Fairchild, dated Jan. 21, 1919, entitled Socket Wrench, identified as Defendant's Exhibit "J" (T. 85);

United States Patent No. 952,435, issued to C. Miller, dated Mar. 15, 1910, entitled Socket Wrench, identified as Defendant's Exhibit "E" (T. 59);

United States Patent No. 1,175,973, issued to M. Miller and A. D. Burg, dated Mar. 21, 1916, entitled Wrench, identified as Defendant's Exhibit "H" (T. 75);

United States Patent No. 1,302,197, issued to M. Miller and A. D. Burg, dated April 29, 1919, entitled Wrench, identified as Defendant's Exhibit "K" (T. 91).

Although all these patents are relied upon by the Appellee as examples of the prior art, principal reliance is had upon the Edmands patent. Appellee, Defendant below, contends in its brief filed in the District Court that the wrenches manufactured by Appellants and by Appellee, which are in substance the same as the Eagle patent, "are also in substance the same as the prior patent to Edmands".

### The Claim to be Construed

As has been pointed out, there is but one claim in the Eagle patent which is set out immediately below and the portions of said claim which are not readable upon Edmands are **printed in boldface type**, for the Court's convenience.

"A wrench comprising a handle having a bifurcated shank, a socket support having one end mounted **and pivotally secured** between the branches of the shank bifurcations **and the other end squared**, a nut engaging socket **having a squared bore adapted to slidably receive**

**the squared end of the socket support therein,** and means carried by the handle and engageable with the rounded end of the socket support to hold the latter in different positions.”

Reference is had to the drawings in the Edmands patent (T. 54). Said drawing discloses that the Edmands' wrench comprises a handle which is in one piece, and a socket head including a socket, and a socket support which latter two elements are integral. The socket head is pivotally mounted at the end of the handle but is not **secured** thereto. That is, said socket head is adapted to be **detached** therefrom. Edmands has provided slotted ears which when arranged in alinement with a flattened surface of the pivot pin, permit the socket head comprising the integral socket and socket support to be disengaged. Thus, the handle in Edmands is adapted to receive and operate with a plurality of integral sockets and socket supports, which can be detached from the handle. In the Eagle patent, a similar range of adaptability for nut sizes is accomplished by **slidably** disengaging said sockets from the socket support and substituting sockets of different sizes. Thus in the Eagle wrench a wide range of sizes is provided by the **slidable** engagement of one of a series of sockets **with the socket support**, while in Edmands a similar range of sizes is secured by disengaging the entire socket head, comprising a socket with its integral support, at the pivot connection with the handle and substituting another socket head. This

difference has resulted in the Edmands wrench being substantially unknown in the art (T. 138), while even Appellee's counsel admitted outstanding success for the Eagle wrench (T. 143).

### **Eagle Wrench Has Enjoyed Unusual Commercial Success**

M. B. Pendleton, general manager of Appellant Plomb Tool Company, testified that his Company has manufactured and sold between thirty-three and thirty-four thousand wrenches embodying the features of the Eagle patent (T. 38). "That would be half of the wrench handle business offered to the automobile mechanic trade" by his Company. This witness further testified (T. 40):

"\* \* \* we are manufacturing more wrenches of the Eagle type than we are all of the other handles put together, and the acceptance of the Eagle type wrench by our trade has rendered obsolete a great quantity of the solid type wrenches \* \* \*."

He was then asked whether their experience as a manufacturer is the experience of other manufacturers competing with them, and he testified that their experience was common throughout the trade. He then testified (T. 40-41) as follows:

"There are approximately sixteen other manufacturers competitive to the Plomb Tool Company making wrenches of both Eagle and other types, and this witness estimated that

the annual manufactured volume of Eagle type wrenches would run somewhere in the neighborhood of 125,000 wrenches per year and that if the experience of other manufacturers is anything like the experience of Plomb Tool Company, that would be half of the wrench handle business offered to the automobile mechanic trade. This witness then explained why the Eagle type wrench has displaced the other type of wrenches as follows:

“A. The reason that the Eagle type of wrench has displaced the various types of solid handled wrenches, is because a mechanic with one Eagle type handle can perform most if not practically all of the jobs and operations which the other solid type handles perform, and obviously a mechanic will gladly buy one handle having a wide and varied use, rather than buy a collection of other type handles which involve expense and inconvenience and duplication.”

Mr. C. F. Carlborg, who has been a machinist since 1900 and an automobile mechanic since 1905 and formerly a partner with Mr. Peterson (now president of Appellee P. & C. Hand Forged Tool Company), which partnership was absorbed by the P. & C. Hand Forged Tool Company, and whose duties in Appellee corporation and previously in said partnership were to handle the shop end of the business and to aid in the design of tools,

testified (T. 124) that he was familiar with the Eagle patent and with the Eagle wrench and that this type of wrench is generally called a flex-handle or hinge handle wrench. This witness testified (T. 138):

“\* \* \* that the defendant company manufactured as many flex-handle wrenches as all other types of handles combined, and that the experience of the defendant company was the same as the experience of the Plomb Tool Company, as testified to by Mr. Pendleton.”

This witness testified (T. 138) that in his experience as a mechanic from 1900 to the date of trial he had never seen a wrench of the type shown in the Edmands patent, nor of the type shown in the Fairchild patent.

J. J. Buhler, called as a witness by Plaintiffs, testified that he was the sales representative of the Plaintiff Plomb Tool Company in Oregon, Washington and Northern Idaho, and that he had been a salesman since 1929, handling sales in California previous to selling in the territory first mentioned, and that prior to becoming a salesman he had been an automobile and truck mechanic for approximately seven years repairing and overhauling tractors, trucks and making general repairs; that he handled the general line of Plomb tools, which included (T. 143) handles, wrenches, standard sockets, ratchets, punches, chisels, etc., and that he sold them to jobbers and mechanics;

that he did not stress any particular kind of tool, but that "the tool game is mostly sockets and handles". The witness testified that he did not carry any of the old style wrenches, such as T-wrenches, speed wrenches, etc., but that occasionally he sold a T-handled wrench when it was ordered "out of the catalogue". The witness testified as compared with the ratchet wrench, T-handles and L-handles adapted to the ordinary socket set, the sales of the flex-handle were equal to the sales of the other handles combined.

### **Appellee Is a Deliberate, Not An Inadvertent, Infringer of Appellants' Patent**

It is not contended by Appellee that P. & C. Hand Forged Tool Company developed its infringing wrench unwittingly and without knowledge of the Eagle patent. The uncontradicted testimony of C. F. Carlborg, formerly vice-president and in charge of the shop of Appellee's business (T. 124), was that some three years prior to the time when Appellee started manufacturing the flex-handle wrench (T. 127) a friend from Salt Lake handed him a pamphlet describing the Eagle flex-handle wrench and socket and that said pamphlet was substantially the same as Plaintiffs' Exhibit "7" (T. 125); that they made up a sample of the same general type of flex-handle wrench and in 1925, which was three years later, they made a flex-handle wrench with a straight handle and a forked, bifurcated socket-holder device with a pin through

it to make a hinge (T. 128) which was the start of Appellee's hinge-handle wrench business.

Samuel Eagle, the inventor, testified (T. 37) that the tool trade was acquainted with his invention by his manufacture and sale of 1,000 wrenches in 1920, and a few in 1921, and that said wrenches were scattered over as wide a sales area as he could to advertise the same.

Mr. M. B. Pendleton, the general manager of Appellant Plomb Tool Company, testified how said Company was advised of the Eagle wrench, stating (T. 151-2) that about 1925 or 1926 a salesman brought to the factory a drawing of a wrench which was substantially the same as the Eagle wrench; that some work was done in connection with the type of wrench and finally in 1926 or 1927 the Plomb Tool Company began the manufacture of the Eagle wrench. He testified:

“We then continued our investigation on this problem, and a series of events continued wherein we were able to locate the patentee, Samuel Eagle, after a great deal of difficulty, and then entered into negotiations with him to take out a license, because we felt that inasmuch as we had begun the manufacture of a wrench which seemed to meet a very great demand, and coincided with his wrench, that we should do the right and honorable thing by taking out a license. Meantime, however, we spent several hundred dollars in engineering work.”



**It is not Appellee's contention that its infringing wrench WAS developed from the Edmands' wrench, but only that said development MIGHT be made by a skilled mechanic.**

The theory that with the Edmands wrench before him and a knowledge of all of the prior art, a mechanic skilled in the tool art **might** conceive and construct the Eagle wrench without exercising the faculty of invention is not based upon actual experience of any of the witnesses but merely upon the opinion of several of Appellee's witnesses that under said circumstances a skilled mechanic would be able to so conceive and construct a flex-handle wrench of this character. To support the theory that the improvement made by Samuel Eagle and defined by his patent claim was a mere mechanical choice and did not involve invention, Appellee called W. E. Kelly, an architect of Milwaukie, Oregon, whose experience with mechanics consisted of a course in steam engineering which he took when he was quite young and in connection with the making of patent drawings and the taking out of a few patents of his own (T. 95). This witness' experience with tools was gained in connection with the work of Appellee and he had no practical experience except using a wrench of the character of the Eagle wrench on his own car. He had never worked at the trade of an automobile mechanic (T. 103). This witness on direct examination testified (T. 97):

“Q. Would there be any mechanical advantage in making these two parts, which are now in one, in two parts; I mean in making the lug and the socket in two separate pieces instead of in one piece? Would there be any mechanical advantage in that?”

“A. I don’t see any advantage at all; this does anything the other will do.”

Further on direct examination, this witness was interrogated on this point as follows (T. 100):

“Q. With the Fairchild patent before you, and with the Edmands patent before you, state whether or not you would consider it difficult for a mechanic to provide means in a wrench for holding the movable socket support in different positions, I mean a spring friction pin, or its equivalent?”

“A. There is no provision made to hold the Fairchild, where there is in the Edmands. The support in the Edmands is very similar to the —.

“Q. Now if I asked you to design a wrench which had socket holding piece, and to provide means for holding that in different positions, angular positions, with the knowledge of these two patents before you, would you find any difficulty in making such a wrench?”

“A. No.”

On cross examination, this witness testified

(104) that all of the parts in the Edmands wrench are old devices of themselves except for their specific form, and qualified his statement that the Edmands wrench would do everything the Eagle wrench would by stating that the Edmands wrench would not accommodate a standard socket without an adapter (T. 105). This witness had previously stated that the Eagle wrench would quickly wear out. On cross-examination he admitted that his previous statement was merely an estimate or guess (T. 105) and that he had had no actual experience with these matters. He further testified that he had never seen the Edmands wrench or the Fairchild wrench in use in any place (T. 106). The Edmands wrench in use further would in one position have its head arranged so that it would fall off and that it was necessary when using said wrench to arrange said head in this position. This witness further testified that if the slot by which said socket head is removed would be closed, it would destroy its utility as a handle with a removable head (T. 107).

Appellee then called R. N. Shinn, a machinist who has had twenty-eight years' training including apprenticeship and some additional supplemental training and testified (T. 108) that he did not think there was any advantage in the Eagle wrench over the Edmands patent. He further testified (T. 108):

“Q. Now just look at the Fairchild patent, defendant's exhibit J, and the model of the

same, defendant's exhibit M. Now with the Fairchild patent before you and the Edmands patent before you, would you find, as a mechanic, any difficulty in providing in a wrench a socket support, a male socket support or square head, as they call it, as a means for holding that socket support in different angular positions with respect to the nut?

"A. No trouble whatsoever.

"Q. What would you think of a mechanic who found difficulty in making such a wrench?

"A. I wouldn't call him a mechanic.

"Q. State whether or not you find any advantage in the Edmands construction over the Eagle construction?

"A. Edmands over the Eagle; I don't see there would be any great advantage, only the cost of manufacture of the Edmands might be a little cheaper."

This witness further testified (T. 111-112) that he had used a wrench pretty much like the Edmands' wrench some years before and bebuilt it, but that this was a long time ago and the details were not clear in his mind (T.116), and that said tool had probably been forgotten by this time except in his own mind (T. 117).

Further, on cross examination he was questioned closely with regard to the cost of producing the Eagle wrenches and the Edmands type wrench,

which latter wrench he had previously testified was cheaper to manufacture. This witness explained that the socket head for Edmands would be drop forged (T. 113) while the little square socket support in the Eagle patent might be "milled out or could be drop forged too". He testified that he never kept any cost accounts of tools and therefore could not give relative costs (T. 114), but believed that it would be easier to tool up for the Edmands socket head. He could not give any testimony as to the cost of tooling up, the time necessary for said manufacturing process, or the expense without quite a little bit of thinking of that and study. He then retracted his statement that tooling up and making dies for drop forging would be cheaper than setting up the head for the Eagle machine in the milling machine and then states positively that it would cost more to tool up for drop forging (T. 115) and that the Edmands would cost most, but that he believed that the cost of the Edmands socket head would be less than the cost of the socket and the head in the Eagle wrench, although he did not know the cost of sockets (T. 116). He further testified that he did not buy sockets; that he had never bought any wrenches of the type of the Eagle wrench or of the type exemplified by Defendant's Exhibit "BB"; that he had not used tools for six or seven years.

### **Eagle Wrench Is True Invention**

Opposed to said theories and faintly remem-

bered incidents is the statement of Appellants' witness M. B. Pendleton that the problem of providing a wrench which would produce the new results desired and which was eventually solved by the Eagle wrench occupied the attention of many inventors and his own company as well; that during the period 1922 to 1929 it was his duty on behalf of the Plomb Tool Company to interview all inventors who came to the factory with ideas for the improvement of mechanics' tools; that during that period there was a repeated demand for some improvement in handles which could be used with the standard socket then in possession of garage mechanics; that during that period the Plomb Tool Company spent "a good many hundred dollars" attempting to devise some sort of a jointed wrench which would meet the apparent demand. He said that his connection with the Plomb Tool Company began in 1918 and although it was not his responsibility until 1922 to interview inventors, he nevertheless saw them at the factory and examined various devices for the improvement of mechanics' tools; that his experience prior to 1922 was the same as it was subsequent to that date so far as the demand for a handle which could be used with standard sockets was concerned (T. 151).

He summarized his opinion with regard to this matter and testified (T. 152) that the Plomb Tool Company adopted and continued to manufacture the Eagle wrench because it met the requirements of a good tool which involved four tests, namely:

Inexpensive to manufacture, correct in design, strong, and "fool proof". He further testified:

"Q. Now, in view of all that work that you were actually put to, what is your opinion as a tool manufacturer whether, with the Edmands tool before him, or the Fairchild tool before him, or any other tool shown in the patents, would a mechanic skilled in the art think of making the changes necessary to producing the Eagle patent?"

\* \* \* \* \*

"A. My opinion is, it would amount to invention.

"A. That it would amount to invention, to take the elements submitted and make an Eagle wrench out of it. Obviously after the Eagle wrench has been constructed it is easy enough to look back and say that anybody can do it, because hindsight is always easier than foresight."

Appellant's witness Buhler testified on cross-examination as follows (T. 150):

"Q. Now taking the Edmands wrench, and taking that piece off there, that socket piece, and putting a hinge lug there, a male part, will that involve any difficulty to an ordinary mechanic?"

"A. How do you mean put an ordinary lug?"

"Q. Just take that piece off and replace that,

and hinge permanently in place a male socket holder, could an ordinary mechanic do that if you asked him to?

“A. No.”

Appellant's witness Carlborg testified that he helped Mr. Peterson of the Appellee Company design tools (T. 124) and that after viewing the circular (Pl. Exh. 7—T. 125) describing Appellants' wrench and after losing the picture (T. 127) he did not reproduce said Eagle wrench but designed a wrench having a handle and a socket support lying alongside of each other rather than one forked over the other and it was several years later that they correctly reproduced the Eagle wrench (T. 128); that Mr. Peterson of the Appellee company then devised a new wrench which he considered an improvement upon the Eagle wrench and obtained a patent on said change predicating a claim of invention on said parts as modified (Pl. Exh. “8”—T. 129-134). This witness testified, however, that the Peterson patented wrench cost more to manufacture as it took slightly more material than the wrench made on the Eagle pattern and would not operate in as small a space as would the Eagle wrench (T. 135). This witness also refuted the testimony of Appellee's expert witness Mr. Shinn with regard to the cost of producing the Edmands wrench as compared to the Eagle wrench. This witness handled the shop end of Appellee's business (T. 124) and he testified that



the Edmands wrench would cost at least twice as much as the Eagle wrench (T. 136). He explained the operations required to make the Edmands wrench and compared them with the operations required to make the Eagle socket support and a standard socket and summarized by saying that it required at least five more operations to make the Edmands wrench than to make a standard socket (T. 134). He testified that the socket support of the Eagle wrench "is very inexpensive, requiring just a short piece of square steel, that is made semi-circular on one end, and a hole driven for the ball." Previous to the introduction of the Eagle wrench, this witness testified that (T. 137) there were many places on the motors and chassis of the car that required a wrench of special design because there were places that were hard to get at. He further testified (T. 138) that mechanics generally spent lots of time on designing wrenches that would eliminate this vast number of wrenches and that he personally spent some time on this problem himself. This witness also refuted the testimony of Appellee's expert witness Kelly with regard to wear of the Eagle wrenches and testified (T. 142) that breakage was a rare occurrence and that he had been using wrenches of this character for the last three years, not every day but a good deal of the time, and they are still as good as ever and that none of said wrenches would wear out in a year's time.

## The Tools Which the Eagle Wrench Replaced

Mr. M. B. Pendleton, general manager of plaintiff Plomb Tool Company, testified (T. 39):

“A. Yes. In the early days of my manufacturing experience we customarily manufactured for the garage trade, garage mechanics’ use, various types of solid handled wrenches, such as the L-wrench, the T-wrench, the solid speed handled wrench, and wrenches having various bends and shapes to get around natural obstructions in the repairing of an automobile.

“Q. Prior to your starting manufacture of the Eagle wrench, these wrenches took care of all the needs of the automobile mechanic, is that true?

“A. Yes; those were the wrenches that were necessary to perform the work that an automobile mechanic was required to do, and we made a very large number of these wrenches in various shapes and sizes; obviously every handle had its own socket as a part thereof, and there were a great many of the solid handled wrenches required to perform the work.

“Q. You say each handle had its own socket?

“A. As manufactured by us, they were all one-piece tools, with whatever shaped handle the case required, and with this opening at-

tached thereto, to the solid piece.

“Q. Did you or did you not manufacture handles which were adapted to be used with sockets?

“A. Yes, we also manufactured handles to be used with sockets, and which were separate yet the handles themselves had to follow the same general shape as did the original solid wrenches with handle and socket all in one.

“Q. When you speak of a T-wrench and an L-wrench, you speak of the shape of the handle as they resemble a capital letter ‘L’ or a capital letter ‘T’?

“A. Yes.”

C. F. Carlborg, a witness for Appellants testified (T. 137):

That he was familiar with the use of wrenches of the character of Edmands and Eagle wrenches; that his first experience with wrenches was as an automobile mechanic; that at said time automobile mechanics had sockets which consisted of a handle with right and left hand ratchets and a number of sockets made out of pressed steel; that garage mechanics at that time had T-handle wrenches made by blacksmiths; that the average mechanic from about 1915 to 1920 and later possessed as high as 150 pounds of wrenches, aggregating about 100 wrenches; that it was necessary to have this number of wrenches in order to do the work in dif-

ferent places on motors and the chassis of automobiles. Mr. Carlborg testified that one wrench would not suffice because there were nuts and bolts of different sizes and that certain operations required wrenches of special design. Respecting this latter matter, he said (T. 80):

“A. There were places on the motors and chassis of the car that required a wrench of a special design, because there were places that were hard to get at.”

The witness testified that since the introduction of flex-handle wrenches the average automobile mechanic is not required to possess as many wrenches as formerly because the flex-handle wrench, with a set of sockets is capable of being used on most of the work done on a motor; that about three flex-handles of different sizes and about 26 sockets were sufficient for the average mechanic at the present time. He stated that prior to the introduction of the flex-handle wrench the average mechanic was required to purchase from \$200 to \$250 worth of wrenches.

J. J. Buhler, salesman for plaintiff Plomb Tool Company, testified (T. 143) that when he worked for the General Petroleum Company as a mechanic, from 1922 to 1929, there was in use solid wrenches of various kinds, standard sockets for which handles were specially made in order to make them usable in difficult places. Buhler testified that during the period he was employed by the Gen-

eral Petroleum Corporation a good mechanic who took pride in his work would have possibly 200 wrenches whereas an indifferent mechanic would have 25 and borrow other needed tools from other employees. He testified that the first flex-handle wrench he saw was in 1928 and that following the introduction of this wrench practically every employee in the shop at the General Petroleum Corporation bought from one to three of these wrenches. He testified further:

“Q. Did they, or didn’t they, discard their old wrenches?”

A. Yes, pretty much so.”

He said that there were approximately 30 mechanics regularly employed and that they all adopted the flex-handle wrench.

This witness further testified (T. 146) that the average mechanic prior to the introduction of the flex-handle wrench had an investment of from \$250 to \$300 in tools. He testified that in some shops, in Ford shops particularly, mechanics now are instructed to discard obsolete handles and to confine their tools to sockets and flex-handles.

### **The New Result Attained By the Eagle Wrench**

As has been pointed out, the Edmands’ wrench differs from the Eagle wrench in that the Edmands’ wrench is provided with an open slot which, when it becomes in registration with a flat portion of the pivot pin in the handle of the wrench,

permits the socket head to slide laterally from the handle and to drop off. This is not so in the Eagle wrench because the socket support is secured to the handle and cannot be removed without driving out the rivet which secures said socket support in place and which constitutes the pivot pin (T. 139). The alinement of said parts occurs at one operative position of the Edmands' wrench as was admitted on cross examination of Appellee's witness Kelly (T. 106) and when this occurred the wrench would not constitute a flex-handle wrench because it would lock or drop off in this position, as was testified by Appellant's witness Buhler (T. 150). This witness also testified with regard to the Edmands' wrench (T. 147):

“A. Exhibit ‘AA’ when that hinge is down, is more or less, seems sloppy, that is, a lot of lost motion; I don’t believe if you are holding something in one hand, and try to hinge it down to advantage, you could do that; you might have to take two hands; it seems to kind of catch in the slides out a little ways. In other words it don’t come back all the way here, like this; you can’t hardly move it, it locks that way.”

Appellants' witness Buhler testified that the Eagle wrench had two advantages: (1) that it was a one-handed wrench and (2) that it was adapted to use standard sockets (T. 148). He testified that the Edmands' device was not adapted to use stand-

ard sockets because there is no place to put standard sockets and that a mechanic understood what a standard or usual socket was, it being a socket with a non-circular hole extending through it, one end fitting the nut and the other fitting the socket support (T. 149). He further testified that the Edmands' wrench could not be used with one hand (T. 149):

“You would have a hard time using it with one hand, to get any speed or anything out of it; also he would be afraid it would drop off in using it in this position on a manifold, unless you happened if you were working in the dark, or unless you were watching real close, you would be picking this thing on and off all the time; it would be bothering.”

Appellants' witness Pendleton summarized the new results attained by the Eagle wrench as follows (T. 42):

“A. The special features of the Eagle wrench comprise the simplest, most inexpensive to manufacture, least trouble type of flex-handled wrench that has yet been conceived, and it makes possible the use of the handle in connection with sockets common to the automobile industry.”

This witness again summarized the advantages and the new results attained by the Eagle wrench (T. 155) as follows:

Q. What in your opinion is the main advantage of the Eagle wrench over the references cited by the defendant as prior art? Can you say that in a few words, what advantages?

“A. The chief advantages are two-fold. One is that the Eagle wrench is a one-handed wrench, and second, that the Eagle is designed to be used with the usual standard sockets in possession of the trade.”

### Opinion of Trial Court

Judge Fee, in his opinion said:

“Since that time there have grown up the use of interchangeable standard sockets which are spoken of by the witnesses. Into these devices handles are mounted and held by friction, just as is exemplified in the Eagle patent.

\* \* \* \* \*

“When one looks at the Edmands’ patent and considers the extensive use to which the standard sockets had been placed before plaintiff’s patent was applied for, it is inconceivable that anyone, whether mechanical or not, if informed of the need of adapting the patented device to the use of the standard socket, could not have evolved the Eagle patent. (135).”

### GROUND FOR REHEARING

The plaintiffs below respectfully petitioned for a rehearing for the following reasons:



(1) That the Court erred in holding and deciding that the single claim contained in the United States Patent No. 1,380,643, granted June 7, 1921, to Samuel Eagle, which is the patent litigated herein, must be held invalid upon the references cited and upon the examples of the purported prior art submitted by the defendant.

(2) That the Court erred in holding and deciding that the fact that several of the elements set out in said claim are old and that several sub-combinations of said element are old, and therefore the single claim of said patent must be construed to have very narrow scope, or to be construed to be of doubtful validity.

(3) That the Court erred in holding and deciding that the Patent Office made a finding that "The socket support of plaintiff's claim with the squarred end is equivalent to an element in the Mandeville Patent consisting of a shank provided with a square nut-receiving chamber, and also is equivalent to the element in the Miottel Patent shown as a recessed socket support. In other words the squarred male element was held an equivalent of the recessed female element."

(4) That the Court erred in holding and deciding that the effect of a preliminary action of the Patent Office, which preliminary action was modified or set aside by a following final or different action, can have any binding or persuasive effect upon this Court in construing said patent.

(5) That the Court erred in holding and deciding that the final statement of the applicant, who was later the patentee of the patent involved in this litigation, did not succinctly point out the exact patentable features involved in his patented invention, namely:

“The two claims now presented for consideration are thought to be allowable, inasmuch as none of the references show a socket support in the form of a solid body having one end pivotally **secured** to the handle, and the other end adapted to be **slidably received** in the bore of the nut engaging socket. With this construction applicant needs no fastening means for holding the socket support and the socket together, depending merely upon the frictional engagement between the parts.

“The references also fail to disclose a socket support or a socket assembled together and held against relative pivotal movement, the socket support being pivotally **secured** onto the handle and adapted to be held at various positions with respect thereto.”

It is to be noted that the underlining is not included in the citation but is added for the purpose of emphasis in this petition.

(6) That the Court erred in holding and deciding that the Edmands' patent, which was not cited as a reference by the Patent Office but was cited by defendant as a purported example of the

prior art, shows any feature or element not shown in the references cited by the examiner, or that defendant contends that said Edmands Patent shows any feature or element not thus shown; that is, that said patent cited by defendant is a disclosure of anything not shown in the references relied upon by the examiner when acting upon the Eagle application.

(7) That the Court erred in holding and deciding that the specific feature “The Edmands patent has the same features except that the socket support and the socket itself **are in one** piece and are adapted to be **removed** from the pivot pin when the eye is opposite to one edge of the lug”, underlining not being present in the Court’s opinion but being included in this petition for the purpose of emphasis, does not constitute that quality of invention to lend patentability to plaintiff’s advancement in the art to which said patent is directed.

(8) That the Court erred in holding and deciding that the fact that in some operations or uses of the two wrenches, namely the Eagle wrench and the Edmands’ wrench, which are being compared, are similar, is not controlling because there are **other new results** not attainable by the use of the Edmands’ wrench, these results being:

1. The Eagle wrench is adapted to accommodate a number of wrench sizes and said accommodation is permitted by the use of standard sockets, which are removable from their socket sup-

ports, while in the Edmands' wrench said accommodation is possible only by the use of a number of integral wrench heads, each of which wrench heads will drop off in one position, and thus the Edmands' wrench is not a one-handed wrench for the reason that one hand must be used in said position to hold said wrench head in place upon its handle; that if the eye of a particular wrench head is closed to make it pivotally **secured** to the handle, it is not capable of being removed for the purpose of substitution, which is the principal purpose of the Edmands' invention and which is the only purpose which would tend to give it any commercial value whatsoever.

2. The Edmands' wrench is not adapted to accommodate **standard sockets**, but said wrench heads being integral structures must necessarily command a higher price and involve special manufacturing tools and processes.

(9) That the Court erred in holding and deciding that the wide-spread use of standard sockets followed the date of the Edmands patent in 1906, rather than preceded it.

(10) That the Court erred in holding and deciding that the steps taken by the patentee Eagle were apparent and were the result of a need sprung up and which was easily and quickly solved, said holding being contrary to the undisputed testimony that the Plomb Tool Company, one of the plaintiffs, spent years in attempting to solve this

problem and the witness Carlborg who was in the employ of the defendant corporation at the inception of the infringing manufacture and sale complained of in the complaint, could not duplicate the Eagle wrench even after it had been illustrated to him.

### ASSIGNMENTS OF ERROR

The District Court permitted the petition to be filed and orally submitted, but denied said petition and plaintiffs below filed the following assignments of error:

(1) Because the District Court adjudged and decreed that the improvement described and claimed in claim one in the letters patent of the United States granted to Samuel Eagle June 7, 1921, number 1,380,643, for an improvement in wrenches, and in which patent plaintiff John William Langs holds an undivided interest and in which patent the Plomb Tool Company holds an exclusive license, did not involve invention and that said claim is invalid and void.

(2) Because the District Court failed and refused to adjudge and decree that said Samuel Eagle invented a new, useful and patentable improvement in wrenches, duly defined and claimed in said claim one of said letters patent.

(3) Because the District Court erred in not adjudging and decreeing that said claim of said

letters patent is valid, that the defendant infringed the same, and that the plaintiffs in their respective relations under said letters patent are entitled to relief from said infringement as prayed for in the bill herein.

(4) Because the said decree of the District Court is in prejudice of the substantial rights and equities of the plaintiffs in the premises.

## ARGUMENT AND AUTHORITIES

### Summarized Contentions

In order to keep conveniently before the Court the various issues bearing upon Appellee's defense of lack of invention, they might be summarized as follows:

(1) The defense of lack of invention is based almost solely upon the wrench disclosed in the Edmands' patent. **It is not contended that the Eagle patent is void for lack of novelty** over the Edmands' patent, but that the differences between the Eagle wrench and the Edmands' wrench do not define a patentable invention. Judge Fee, in his opinion, pointed out that the differences between said wrenches are that "the Edmands' patent has the same features except that the socket support and the socket itself are in one piece and are adapted to be removed from the pivot pin when the eye is opposite to one edge of the lug".

(2) The Edmands' patent was issued in 1906.

The Eagle patent in question issued in 1921, therefore a period of over fifteen years elapsed between the issuance of the two patents.

(3) It is not contended by the defendant below that anyone **perceived** or **conceived** that the difficult problem of providing a wrench (1) adapted to accommodate a number of nut sizes and (2) adjustable sufficiently to avoid obstructions in the use of such a wrench about an automobile, for example, could be attained by modifying the old Edmands' wrench so that all of the parts would be tied effectively together and constitute a one-handed wrench, and so that it could use standard sockets.

(4) The Edmands' wrench represents merely a paper patent and no one seriously contends that said wrench proved practical or useful, and it never took its place in the art as a useful tool. That is, the issuance of the Edmands' patent had no effect upon the state of the art except that it was a development which was called to the attention of the art by the issuance of a patent and was practically ignored by said art.

(5) The ignoring of the Edmands' wrench by the art was not mere lack of appreciation thereof. This is most conclusively demonstrated by the fact that the defendant below could have adopted said wrench and used it without fear of infringement when it entered the wrench field with a flex-handle wrench in 1924, because at that time the Edmands

patent had expired and was public property.

(6) The need for a flex-handle wrench was not one which sprung up due to any sudden change in the art, but the need for a wrench of this character was appreciated by the art for a long period of time and during this entire period manufacturers and mechanics in the field attempted actively to devise a wrench capable of attaining the result produced by the Eagle wrench.

(7) This problem was troublesome and important to the art, as is demonstrated by the fact that as soon as the problem was solved by the patentee Eagle, the wrench immediately was adopted until over one-half of the wrenches sold, or approximately 125,000 annually, were Eagle flex-handle wrenches.

(8) The field in which the flex-handle Eagle wrench has its greatest application is in the automobile repair business. This has occupied the attention of many thousands of mechanics and technical engineers and so it is proper to assume that greater attention was paid to the problem of satisfying the need than if the art were one in which the need was evident to only a few persons. In this regard, the Edmands' patent was directed to the same art (T. 56, lines 13-18). In other words, the Eagle wrench was adapted to solve a known deficiency in the art, not that the art was modified and new tools were designed to accommodate said modification.



(9) Each mechanic in the art had a personal and selfish reason for devising such a wrench, beyond his natural desire to create, because wrenches of this character were purchased by the mechanic personally. It was necessary for each mechanic to provide himself with from twenty-five to two hundred solid handle wrenches of the reasonable value of several hundred dollars to produce the same results attained by from one to three different sizes of Eagle flex-handle wrenches and a set of standard sockets.

(10) When the Eagle wrench was devised and introduced into the art, its commercial success and its adoption and acceptance was instantaneous and its infringement by defendant below demonstrates what the art, including this infringer, thought of said improvement.

(11) The Eagle wrench is now standard equipment with automobile mechanics and they abandoned their other tools which they had previously used.

(12) The Appellant Plomb Tool Company acknowledged its infringement of the Eagle patent and secured a license thereunder, while the Appellee deliberately infringed and refused to discontinue infringement upon receipt of notice.

(13) Defendant below, Appellee herein, sets up its defense of lack of invention based not upon its own **experience**, nor upon the **experience** of anyone else, but only upon a **theory** of what might have

been done **if**

(a) Someone had **perceived** that the solution to this vexing problem of providing a multi-purpose wrench could be achieved by a flex-handle wrench with standard sockets;

(b) Someone had **conceived** that this result could be accomplished with a handle comprising two parts ~~not merely~~ joined by a simple axial pivot, one short section of said handle constituting a **support for standard sockets** and held against free rotation about its pivot axis by a spring-pressed member, so that the other portion of the handle might serve as an effective lever when arranged at an oblique angle with said socket support, as well as a flexible member, to avoid obstructions.

(c) Someone had **reduced it to practice** by incorporating such a structure in a wrench having the function and result of the Eagle wrench, as is set out in the single claim of the Eagle patent.

(14) Appellee herein sets up its theory of lack of invention in the face of its own unsuccessful experience in attempting to devise a wrench to meet the difficulties encountered. Its own wrench designer, even after having pointed out to him the perception that a solution was possible to said problem and the correct conception, was unable to reproduce said wrench from memory in an efficient manner. Also, the president of P. & C. Hand Forged Tool Company, Appellee herein, in an at-

tempt to avoid direct infringement and to improve upon the Eagle wrench, devised a modification thereof and secured a patent thereon, but still manufactured the Eagle type wrench in its identical form as claimed in the Eagle patent.

### What Constitutes Invention

As was said by Justice Brown in **McClain v. Ortmyer**, 141 U. S. 419, 427, 12 Sup. Ct. 76, 35 L. Ed. 800, the word "invention" "cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involved an exercise of the inventive faculty or not". The act of inventing, however, consists of three definite steps. The authoritative work of **Robinson on Patents**, Vol. 1, page 116, paragraphs 77 and 79, points out these steps as follows:

1. The perception of a need;
2. The conception of a mode of attainment;  
and
3. Reduction to practice.

The first two steps of "what to do" and "how to do it" are mental acts and the last step of physically making or performing the operation is a physical act.

**"Section 77. Inventive Act Twofold: Mental and Physical.** Every invention contains two elements: (1) An idea conceived by the inventor; (2) An application of that idea to the

Production of a practical result. Neither of these elements is alone sufficient. An unapplied idea is not an invention. The application of an idea, not original with the person who applies it, is not an invention. Hence, the inventive act in reality consists of two acts; one mental, the conception of an idea; the other manual, the reduction of that idea to practice. It is especially in the mental act that the questions which confront us find their answer.

**“Section 79. Mental Part of Inventive Act Includes a Conscious Perception of the Idea Generated by the Creative Faculties.** Moreover, no exercise of the creative faculties can form a part of the inventive act, unless the idea resulting from such exercise is fully apprehended by the mind of the inventor. To create by accident without a recognition of the fact or nature of his own creation, and consequently without the power to repeat the same creative act, is not invention. While previous intention to create in this especial form, or even to create at all, is not required, it is essential to the inventive act that the inventor should not only **conceive**, but should also **perceive** his original idea, and should do both so clearly as to make this idea an actual addition to his fund of knowledge, and to be able to communicate it to the public.”

**Robinson on Patents, Vol. 1, p. 116, 121.**

The familiar analogy between the performing of an inventive act and the discovery of a path to a desired goal illustrates these respective steps.

It is necessary not only to be looking for a path (perception of a need), and to forecast its location (conceive the mode of attainment), but it is necessary also to blaze, construct and traverse such path (reduce to practice) in order to complete said discovery (invention).

Robinson adds:

**“Section 80. Mental Part of Inventive Act Complete Only When the Idea Generated is Sufficiently Developed for Practical Application.** Again, the idea in which this exercise of the creative faculties results must be complete and capable of practical application. To recognize a public want, to entertain vague notions of some mode in which that want may be supplied, to put forth efforts which approach, however nearly, to the solution of the problem and yet leave it unsolved are not enough. Such operations never pass beyond the line of mere conjecture or of unsuccessful experiment. They **create** nothing; and though they tend to stimulate and aid creative genius, they are in themselves useless both to the inventor and the public. To him alone whose mind conceives the perfect, practical, operative idea,—that idea which when embodied in tangible materials, will accomplish the desired re-

sult,—belongs the right of the inventor and the credit of performing the inventive act.

**“Section 83. Mental Part of Inventive Act Complete Whether Prolonged or Instantaneous.**

The law draws no distinction between those operations of the creative faculties which manifest themselves in long-continued study and experiment, and those which reach their end by sudden intuition or apparent accident. Here also is a region in which human knowledge is at fault. Indeed, it may well be doubted whether the creative act is ever otherwise than instantaneous and intuitive, and whether research and reflection ever do more than clear the way for, and dispose the mind toward those sudden apprehensions of the truth to which in literature and the arts we give the names ‘invention’ and ‘discovery’. The law does not attempt to settle questions which thus lie beyond the reach of mental science. Whenever the creative faculties have evidently been at work, it inquires neither as to the method nor the duration of their exercise. The patient labors of a lifetime, the unpremeditated flash of an original thought upon the mind, the revelation made to an appreciative intellect by some trivial accident, all stand upon an equal footing both in character and merit, and are entitled to the same reward.

**“Section 84. Mental Part of Inventive Act**

**Complete Though Aided by External Suggestions.** Nor does the law take notice of the aid which the inventor has derived from the suggestions, writings, or experiments of others, provided the creative act be truly his. Unless the idea which constitutes the spirit of his invention has been obtained by him from other persons, complete and capable of practical application, it is his own creation and not theirs, however closely their imperfect notions may approach to his. The law can draw no line between the ideas suggested to his mind by such external objects, and those which his mind generates from these suggestions. It can look only to the words and things from which his ideas may have been derived, and if it cannot find in them, apparent to the public view, the entire original idea as claimed by the inventor, it does not venture to dispute his right.

**“Section 85. Mental Part of Inventive Act Complete Though the Idea Generated Be of Small Value.** Lastly, the magnitude of the results which flow from the inventive act furnish no test by which its merits are determined. The advance made by the inventor may be slight, the benefit conferred upon the public may be small, but though these considerations influence the recompense which he eventually receives, they do not affect the intrinsic character of the creative act. The exercise of the

inventive faculties in the production of a practical result having been once conceded, the degree and quantity of inventive skill which it involves are immaterial. It falls within the purview of the law as an invention, and is entitled to the same protection as if it were the most important of discoveries.”

Following the analogy, previously indicated, it might be said that it is not necessary that the discovered path leads through an unchartered wilderness (pioneer patent). But on the other hand, it might follow along a maze of well-beaten paths (crowded art) utilizing a portion of each intersecting path (combination of old elements) to arrive at the desired goal. We cannot measure the path to see whether it exceeds a given pre-determined length (the amount of change), nor can we consider the fact of whether the discoverer of said path was inspired (flash of genius) or produced said discovery by the more time-consuming method of trial and error (experimental processes) to find a yard stick to measure the **quality** of the discovery (invention).

All of these simple steps, as applied in this homely analogy, have been clothed in legal terminology, particularly applied to patents, until it some times seems that elementary principles are forgotten or ignored. This fact was recognized by Robinson (*supra*) as early as 1890, and reverting to elementary principles, as outlined by this



learned and authoritative writer, is of assistance.

Prefacing the portions set out above, Robinson says:

**“Section 73. Difficulties of the Subject Caused by Failure to Apprehend the True Nature of An Invention.** In discussing these topics we shall encounter certain difficulties, inseparable from any system of positive law which attempts to regulate matters relating to imperfectly understood mental or physical facts. Such systems are not the development of evident and necessary truths, but are built up through the interpretations given by the courts to the terms in which the arbitrary will of the legislative body is expressed; terms not always carefully selected, nor accurately adapted to the subjects which they are intended to control. In all such cases, the nature of the fact to which the law relates, as well as the reason of the law and the principles by which its application must be governed in order that the system may be permanent and beneficial to the state, are of gradual and late discovery; and the efforts of the courts to grasp and formulate them are characterized by many apparent contradictions, by much uncertainty of language, and by the frequent confusion of ideas which are, in themselves, essentially dissimilar. These difficulties are perhaps less formidable in the present system than in any other, owing partly to its narrow limits, partly

to the fortunate expressions which are contained in both the American and English statutes, but they nevertheless exist; and hence, in the examination of the text-books and reported cases, the exercise of constant caution becomes necessary, lest by the overlapping and interlacing of propositions which are really distinct, or by the substitution of the rules governing one branch of the subject for those which properly control another, the reader should be needlessly misled. To remedy as far as possible these evils, our own examination of the system will begin with an endeavor to ascertain the nature and essential attributes of an invention.”

Following this analogy, we might consider the starting place of said path and the location of the old paths, the state of the art; the travelers and those interested in travel along this path, or along the previous paths, those skilled in the art; the search for the new path, perception; the forecasting of its eventual location, conception; the demonstration of its location and the feasibility of traveling along said path and the blazing and construction thereof, reduction to practice. The grant of a franchise covering the right-of-way along said path might be compared to the grant of letters patent; the various integral portions of the path might be considered the elements of the claimed invention, and all of the right-of-way, or the entire path might be considered the combination claimed; the

amount of eventual travel over the right-of-way might be compared to the commercial success of the invention and trespass over said right-of-way compared to infringement and so on through the entire terminology as applied to patents.

Therefore, the three component parts or steps in the creation of an invention, namely, (1) what to do, or perception; (2) how to do it, or conception, and (3) the doing of it, or reduction to practice, are of equal importance in producing an invention.

Invention might thus be described as a stool resting upon the three legs, perception, conception and reduction to practice. Each is of an importance equal to that of either of the others and must support equal weight. Therefore, if one leg were missing there would be no support given by the other two legs. Perception and conception without reduction to practice does not represent a complete invention. It likewise would be improper to consider the inverse of this premise in measuring invention—namely, first presuming that you have a stool with two legs and then measuring how difficult it would be to fashion and fit the third one. Likewise identity of invention is present only when devices have the identical or equivalent structure, function and result and when they are directed toward the solution of the same problem. That is, two stools being compared must each have all three legs and must look alike, act alike, and produce the same result.

It is therefore erroneous to stress the physical step over the mental steps in testing whether or not an invention has been made, for frequently

“‘It often requires as acute a perception of the relation between cause and effect and as much of the particular intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo*, and this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before.’”

Potts v. Creager, 155 U. S. 597, 608, 15 Sup. Ct. 194, 198, 39 L. Ed. 275.

The line of defense adapted by Appellee herein is strikingly similar to that urged by the defendant in **Carnegie Steel Co. v. Cambria Iron Co.**, 185 U. S. 403, 446; 46 L. Ed. 968, 989, which commented upon the opinion of Mr. Justice Bradley in **Loom Co. v. Higgins**, 105 U. S. 580, 591: ‘But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice \* \* \* Now that it has succeeded, it may seem very plain to any one that he could have done it as well.

This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention.'

The fallacy of a defense to establish the presence or lack of invention upon the ease or difficulty of the reduction to practice is that it first must be assumed that the two mental steps in the act of inventing have been done, namely:

(1) That someone **perceived** that there was a need of forming the combination covering the patented structure; and

(2) That some one **conceived** that said end could be attained in some definite manner. After it has been pointed out that there is a need for doing something and that it can be done in a certain manner, many persons can follow the suggestion made to reduce said device to practice. This is nicely put by Mr. Pendleton (T. 152):

"It would amount to invention, to take the elements submitted and make an Eagle wrench out of it. Obviously after the Eagle wrench has been constructed it is easy enough to look back and say that anybody can do it, because hindsight is always easier than foresight."

This might be compared to the average problem which must be first perceived and a satisfactory

structure conceived by an engineer and plans produced for accomplishing the desired result. After a structure has been devised and blue-prints made for producing said structure, any mechanic of ordinary skill can follow the plans as incorporated in a blue-print thus merely following the suggestions of the designer.

Following the analogy between the inventive act and the discovery of a path to a desired goal, the trail builder is not given the advantage of having pointed out to him the probable route he is to follow and given the assurance that following said general route he will successfully attain his goal. Said trail builder on the other hand, after he has completed the first step of perceiving that there is a need for a trail between his starting place and his goal, must seek out **some** successful path to said goal along **some** line and with the **hope** that he will eventually be able to find a path. There may be a maze of intersecting paths leading to other goals, there may be other and different paths leading to the same goal. If the path or route considered as a whole is new, **and novelty is not an issue in this** case, and said path leads from the starting point to the goal in a new and better manner and thus produces a new and beneficial result, said route will be considered a new path independently of whether it traverses portions of intersecting paths leading to the same or to different goals, or whether it is directed across unmarked territory. In the present case, it is not

a proper test for invention to consider the Eagle wrench as a completed invention, then to compare it with every previous example of the prior art and independent of the results or functions of the various examples of the prior art, and then to select the device having the greatest similarity thereto and to point out the various changes and modifications which **might** be made and to predicate invention upon the ease or difficulty with which said changes can be made. That would be hindsight rather than foresight. The proper test is to determine whether anyone has perceived the need of making said changes, had conceived a mode of accomplishing the end desired, and has accomplished said end.

“Patentability has often been found ‘in discovering what is the difficulty with an existing structure’ and correcting the same, even though ‘the means’ are old and their mere “adaptation to the new purposes involves no patentable novelty.’ *Meihle, etc., Co. v. Whitlock*, 223 Fed. 647, 650, 139 C. C. A. 201. Hindsight, or wisdom after the fact, has always been looked upon with disfavor; e.g., *Faries Co. v. Brown*, 121 Fed. 547, 550, 57 C. C. A. 609.”

*Kurtz v. Belle Hat Lining Co.*, 280 F. 277.

The same line of attack was commented upon in *Potts v. Creager*, 155 U. S. 597, 15 Sup. Ct. 194, 39 L. Ed. 275:

“And this is not the less true if, after the thing is done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before. The apparent simplicity of a new device often leads an unexperienced person to think that it would have occurred to any one familiar with the subject; but the decisive answer is that, with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of the mechanic may be safely trusted to see what ought to be apparent to everyone.”

The late case in this the 9th Circuit of **Bankers Utilities Co. v. Pacific Nat. Bank**, 18 F. (2d) 16, 18, discloses a defense of a similar nature and several citations from the opinion are pertinent.

“Anticipation is not made out by the fact that a prior existing device, shown in a prior patent, may be easily changed so as to produce the same result as that of the device of the patent in suit where the prior device was in common use, without it occurring to any one to adopt the change suggested by the patent in suit. *Blake Automotive Equipment Co. v. Cross Mfg. Co.*, 13 Fed. (2d) 32. In their position plaintiffs are fortified by the presumption attending a patent. *Wilson & Willard v. Bole*, 227 Fed. 607; *Heinz v. Cohn*, 207 Fed. 547; *San Francisco v. Beyrle*, 195 Fed. 516, and by



the fact that their device is a commercial success and has brought on imitation (application of *McClaire*, 16 Fed. (2d) 251; *Sandusky v. Brooklyn Box Toe Co.*, 13 Fed. (2d) 241; *Carson v. American Smelting Co.*, 4 Fed. (2d) 463; *Murphy Wall Bed Co. v. Rip Van Winkle Wall Bed Co.*, 295 Fed. 748; *Globe Knitting Works v. Segal*, 248 Fed. 495; *Morton v. Llewellyn*, 164 Fed. 697.”

### Patentable Invention—Authorities

The authorities were ably collected and differentiated by the Court in the case of **Kurtz v. Belle Hat Lining Co.**, 280 F. 277, 279, involving a hat lining patent which had been held to display nothing patentable in the District Court. The Circuit Court of Appeals for the Second Circuit, on reversing the lower decree, said:

“Thus is presented the question of invention, admittedly one of fact, yet also one as to which courts, composed of lawyers, have long been anxious to act with uniformity and along lines of thought which will result in precedents, instead of mere incidents. Despite the warning of Justice Brown in *McClain v. Ort-mayer*, 141 U. S. 419, 427, 12 Sup. Ct. 76, 35 L. Ed. 800, that the word ‘Invention’ ‘cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involved an exercise of the inventive faculty or not,’ the effort still con-

tinues. Prof. Robinson analyzed all of these attempts down to his date of publication (1890) which was but a few months before Brown, J., pronounced the effort futile. *Rob. Pat. Vol. 1, p. 116 et seq.* Yet there remains as always worthy of consideration the learned author's dictum that 'the mental faculties involved in the inventive act are the creative and not the imitative.' Section 78. In comparatively late years efforts at positive statement have been limited to such generalizations as that—

“‘Invention, in the nature of improvements, is the double mental act of discerning, in existing machines or processes or articles, some deficiency, and pointing out the means of overcoming it.’ *General Electric v. Sangamo, 174 Fed. 246, 251, 98 C. C. A. 154, 159.*’

“‘What may be called negative definitions or partial descriptions are still and always have been very common. Thus:

“‘Every result obtained by deliberate reflection and experimentation with well known appliances, or parts thereof, is not necessarily invention within the \* \* \* patent laws.’ *Lord v. Payne (C. C.) 190 Fed. 172.*

“‘Invention involves conception of at least some function, as well as the selection of the means whereby that function can be operatively secured.’ *U. S. Co. v. Hewitt, 236 Fed. 739, 150 C. C. A. 71.*

“‘If \* \* \* the mind advances from the known to the unknown by a transition natural to the ordinary instructed intellect, there is no invention. *Farnham v. U. S.*, 47 Ct. Cl. 207.’

“‘Again a certain device was invention because:

“‘It was a true discovery. It involved uncovering a thing which, while long capable of being done, was never before thought of. It also afforded a medium or means for bringing the discovery into practical action, and put it into the hands of others, there to be turned to pleasurable and profitable uses.’ *Cunningham v. Aeolian*, 255 Fed. 897, 900, 167 C. C. A. 217, 220.

“‘The enormous multiplication of improvement patents has produced such sayings as:

“‘It often requires as acute a perception of the relation between cause and effect, and as much of the peculiar intuitive genius which is a characteristic of great inventors, to grasp the idea that a device used in one art may be made available in another, as would be necessary to create the device *de novo*. And this is not the less true if, after the thing has been done, it appears to the ordinary mind so simple as to excite wonder that it was not thought of before.’ *Potts v. Creager*, 155 U. S. 597, 608, 15 Sup. Ct. 194, 198 (39 L. Ed. 275).’

“It has even been thought necessary of late to dwell upon the presumptions; thus a given device—

“Certainly (was) not in an exact repetition of the prior art. It attained an end not attained by anything in the prior art. \* \* \* It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character; \* \* \* knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing \* \* \* was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration.” *Diamond, etc., Co. v. Consolidated*, 220 U. S. 428, 434, 31 Sup. Ct. 444, 447 (55 L. Ed. 527).

“(1) The foregoing quotations, which might be multiplied, only prove the truth of Justice Brown’s dictum, and enforce the other truth which we attempted to point out in *Kimball*

v. Noesting (C. C. A. 262 Fed. 148, viz: that invention is a question to be decided on the evidence. The problem is the more difficult because evidence as to invention does not often give rise to conflicts of fact in the ordinary sense of that phrase; it does, however, give rise to acute differences of opinion as to the inferences to be drawn from facts in themselves uncontradicted; and this is as true of what is called 'opinion evidence' as it is of testimony regarding things visible or tangible. It is probably for this reason that experience has dictated some canons of decision (they are not rules of law) as to how the problem of invention is to be approached.

“(2) Thus it has been well said that ‘in determining this question it is proper to bear in mind the condition of the trade as well as the art to which the patent in suit is allied.’ Warren, etc., Co. v. American, etc., Co. (C. C.) 133 Fed. 304, 306. And similarly that the ‘effort (of the court) must always be to view the subject matter from the standpoint of the art concerned.’ Kurtz v. Blatt (D. C.) 263 Fed. 392, 394. It is also the duty of the court to construe patents liberally, so as to effect their real intent. Bossert v. Pratt, 179 Fed. 385, 387, 103 C. C. A. 45. And cf. Auto Vacuum Co. v. Sexton, 239 Fed. 898, 153 C. C. A. 26.

“Yet when all has been done, the question of invention may ‘be answered differently by per-

sons of equal intelligence.' *Bossert v. Pratt*, supra, 179 Fed. 386, 103 C. C. A. 46. We think, also, courts have always endeavored to observe at least some of Prof. Robinson's guiding rules (supra), as that the nature of an invention is usually ascertained from examining the inventive act from which patented matter results; for invention always generates a new idea, although a patentee must create the means, and not merely perceive the end.

"(3) Result is that study of well-considered decisions under this head will always show that result is reached very largely from examination of 'the results obtained.' *Doble v. Pelton, etc., Co.* (C. C.) 186 Fed. 526. Results are described by abstract nouns, like 'simplicity', 'economy', etc., and, while it is always admitted and stated that the mere attainment of such desirable results is not invention, they always have been and must be used as evidence or indicia of invention, and the weight and probable effect of such marks of excellence have varied, and always must vary within limits according to the personal equation of the fact trier.

"Thus, while neither simplicity, cheapness, nor utility—nor all three combined—constitute invention, they have been deemed most potent evidence thereof. *Barry v. Harpoon Co.*, 209 Fed. 207, 126 C. C. A. 301. Simplifying form

and cheapening cost have been accorded the same potency (Hunt v. Milwaukee, etc., Co., 148 Fed. 220, 78 C. C. A. 116), although, of course, such excellence must always be accompanied by a 'different result' (Bernz v. Schaefer (D. C.) 205 Fed. 49, 52). Indeed, it has been thought that simplicity alone, though 'cited as evidence of lack of invention, to our minds shows a high order of novelty and invention' (Consolidated, etc., Co. v. Window Glass Co. (C. C. A.) 261 Fed. 362, 375), and to the same point Hills v. Hamilton Co. (D. C.) 248 Fed. 499.

"Utility, though itself not invention, nor conclusive evidence thereof, has been practically accorded the greatest weight. Union, etc., Co. v. Peters, 125 Fed. 601, 60 C. C. A. 337; Woerheide v. Johns-Manville, 220 Fed. 674, 136 C. C. A. 316. Cf. Greenwald v. LaVogue, 226 Fed. 448, 141 C. C. A. 278. Novelty, likewise, has been pushed to the front as a piece of evidence. Concrete, etc., Co. v. Meinken (C. C. A.) 262 Fed. 958, 965.

"The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think. David v. Harris, 206 Fed. 902, 904, 124 C. C. A.

477; *Smith v. Peck* (C. C. A.) 262 Fed. 415, 417. Commercial success has been too recently and too often considered to justify much citation; but, however unsafe as a guide (*Boston, etc., Co. v. Automatic* (C. C. A.) 276 Fed. 910), it has always been a powerful piece of evidence, especially when the prior art shows no success along the same lines (*David v. Harris, supra*).

“The list of laudatory epithets descriptive of what is considered evidence is by no means exhausted; the ‘marked superiority of the article’ constructed under the patent (*Frost v. Cohn*, 119 Fed. 505, 56 C. C. A. 185); ‘a marked improvement in product’ (*Greenwald v. Enochs*, 183 Fed. 583, 106 C. C. A. 351); the ‘ingenuity and popularity’ of the patentee’s product (*Fligel v. Sears*, 254 Fed. 698, 166 C. C. A. 196); the ‘unchallenged supremacy’ of the same (*Consolidated, etc., Co. v. Firestone, etc., Co.*, 151 Fed. 237, 80 C. C. A. 589); and even the aid given by the patented article in ‘advertising and identifying’ an entirely different product (*Fonseca v. Suarez*, 232 Fed. 155, 156, 146 C. C. A. 347)—have all been used, and we think properly so, as evidence of invention.

“Patentability has often been found ‘in discovering what is the difficulty with an existing structure’ and correcting the same, even though ‘the means’ are old and their mere



patentable novelty.' *Miehle, etc., Co. v. Whitlock*, 223 Fed. 647, 650, 139 C. C. A. 201. Hindsight, or wisdom after the fact, has always been looked upon with disfavor; e.g., *Faries Co. v. Brown*, 121 Fed. 547, 550, 57 C. C. A. 609.

“(4) If we viewed this hat lining, or any hat lining, in the light of our own experience, it would appear trivial and unworthy the dignity of patent protection; but, looking at it through the evidence and (we hope) with the eyes of the hat lining trade, this patent represents a large and successful business. It is in the minds of all those who deal in hat linings, of the utmost importance. No one ever made a lining of such simplicity, cheapness, and general adaptability as has Kurtz, and he has done it by mechanical means of winning simplicity, to all of which defendant has testified by deliberately imitating Kurtz’s product and engaging in expensive litigation to defend the imitation.

“We are of opinion upon this record that Kurtz’s hat lining is novel, useful, and displays patentable invention.”

### OPINION OF DISTRICT COURT

It would appear that Judge Fee, in rendering the opinion upon which he based his decree, failed

to appreciate the difference between a claim and the elements of a claim going to make up a combination. In the first page of his opinion (T. 160) Judge Fee cites the fact that the Patent Office, in adjudicating the various claims put forward by the patentee Eagle then an applicant before the Patent Office, held various elements in the different combination claims to be old. He states that the **elements**, which he sets out specifically, are **claims**. It is submitted that it is immaterial, with regard to the patentability of the **combination** claimed, whether or not the **elements** are old per se. In considering combination claims, it is even **presumed** that the elements are old.

The Court cites the final contention of the patentee, then an applicant before the Patent Office, in which he differentiates his allowed claim, which is now at issue, from the art of record. This statement of the patentee, then an applicant, clearly distinguishes the claim from the art of record and the art cited by Appellee herein, and the Court in its opinion correctly summarizes these differences in the second and third paragraphs of his opinion on page 162 of the Transcript, but **searching for new elements** the Court concludes at the bottom of page 161 of the Transcript that **he finds no new elements**.

In its opinion, the Court states (T. 163, third paragraph):

“It has been noted above that Edmands

adopted the device of an interchangeable female member on his wrench in 1906. Since that time there have grown up the use of interchangeable standard sockets which are spoken of by the witness.”

As has been pointed out, said statement is not supported by the testimony, and on the other hand the only testimony covering the time when standard sockets were first used is that of C. F. Carlborg, witness for Appellant, who testified that his first experience with sockets was when he was an automobile mechanic (1905-1915) (T. 124). It is not believed that the Appellee herein would contend that “the use of interchangeable sockets grew up since 1906.”

It is further submitted that the statement “It is inconceivable that anyone, whether mechanical or not, if informed of the need of adapting the patented device (Edmands) to the use of the standard sockets could not have evolved the Eagle patent” does not represent a true test for the quality of invention. **This statement is based upon the premise that the invention has previously been perceived and conceived and measures merely the ease or difficulty of its being reduced to practice.**

The case of **George Frost Co. v. Cohn**, 112 F. 1009, 1011-12 (commonly referred to as the garter case), involves a similar defense, and relates to the use of a rubber covered stud in hose supporters. The solution to this problem is even more

simple than the claimed invention and the patented claim in question. The Court said:

“\* \* \* For many years an army of inventors and skilled mechanics were at work to remedy these defects. All sorts of expedients were resorted to, but the old difficulties remained. At length Gorton substituted for the metal button a button with a rubber shank, and the thing was done. This, the defendants insist, was a perfectly obvious thing to do. Every one who wore goloshes, or rode a bicycle, or placed a band around his papers, or played golf or tennis knew the properties of rubber. There was not an intelligent mechanic who did not know that rubber is more resilient and clinging and less likely to cut woven fabrics than steel or iron.

“Here was a situation, say the defendants, where a hard, unyielding substance had been tried and found wanting and where a soft, gripping substance was needed in its place. Rubber possessed all the required qualities and everyone knew it. What then was more natural than to use rubber? This argument has been so often considered by the courts that little of value can be added to the discussion, and, after all, the old answer is the best answer,—‘No one did it before.’ The record shows that for at least ten years prior to Gorton’s invention men skilled in the art were endeavoring to

make an operative supporter and several had so far succeeded as to secure patents, but always along the same lines. There was always the metal button, there was always the fabric clamped between two metallic surfaces. Rubber, in almost every conceivable shape and form, was everywhere in use, but no one thought of it. Like a jewel lost in a crowded thoroughfare,—multitudes pass it unnoticed, some actually tread upon it, others stop and gaze for a moment, but hurry on deeming it some worthless tinsel; at last comes one who recognizes its value and picks it up. Others might have done this it is true, but they did not; he did, and is entitled to the prize which he has rescued from the mire. If one should attempt to snatch the gem from the finder on the ground that he passed it frequently and could have picked it up as well as not, he would in all probability be promptly turned over to the police as a thief or a lunatic. It is this capacity for accomplishing results, this faculty of seeing what others fail to see and hearing what others fail to hear which has always distinguished success from failure and the inventor from the mechanic. ‘In the law of patents it is the last step that wins,’ says the Supreme Court. This is the step which Gorton took.”

It is further submitted that the statement contained in the final paragraph of Judge Fee’s opinion:

“But it would be unfair and unjust to permit one by a clever **combination of devices old in the art** and which already belong to the public, to monopolize a field and take from the people at large what already belongs to them” is contrary to all of the authorities.

IT IS NOT ESSENTIAL TO A PATENTABLE COMBINATION THAT ANY OF THE ELEMENTS BE NEW AND IN FACT IT IS THE USUAL COMBINATION WHERE ALL OF THE ELEMENTS ARE OLD PER SE.

“Inventions pertaining to machines may, for the purpose of such explanations as the court find it necessary to give you in this case, be divided into four classes. First, where the invention embraces the entire machine, as a car for a railway, or a sewing-machine, as was decided by this court in a well-known case. Such inventions are seldom made, but when made, and duly patented, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make, use, and vend to others to be used, the entire machine; and if another, without license, makes, uses, or vends any portion of it, he invades the right of the patentee.

“The second class of inventions referred to are those which embrace one or more of the adaptation to the new purposes involves no

elements of the machine, but not the entire machine; as the coulter of the plough, or the divider of the reaping-machine. In patents of that class any person may make, use or vend all other parts of the machine or implement, and he may employ a coulter or a divider in the machine mentioned, provided it be substantially different from that embraced in the patent.

“The third class of machines which are to be mentioned are those which embrace both a new element and a new combination of elements previously used and well known. The property in the patent in such a case consists in the new element and in the new combination. No one can lawfully make, use, or vend the machine containing such new element or such new combination. They may make, vend, or use the machine without the patented improvements, if it is capable of such use; but they cannot use either of those improvements without making themselves liable as infringers.

“The fourth class of machines to be mentioned are those where all the elements of the machines are old, and where the invention consists in a new combination of those elements, whereby a new and useful result is obtained.

“Most of the modern machines are of this class, and many of them are of great utility and value.”

Union Sugar Refinery v. Matthiesson, 24 Fed. Cas. 686, 687.

A number of other cases are collected in 48 C. J. Patents, Sec. 87, to the effect that:

“Where there is no direct anticipation (of a combination) invention is not negatived by the mere fact that some or all of the elements of the combination are old. The question is whether they have been newly combined so as to effect new and useful results.”

The principles which govern the issue here involved have also been repeatedly and clearly announced in this the Circuit Court of Appeals for the Ninth Circuit. One instance is found in the case of **Doble v. Pelton et al.**, 186 F. 526, so ably decided by the late Judge Van Fleet (referred to by the C. C. A. 2nd in its above abstracted opinion expressed in **Kurtz v. Belle Hat Lining Co.** (*supra*).

The patent there considered was the reissued patent to Doble, February 27, 1906, No. 12,460, for an improvement in Nozzles for Impact Water Wheels. The problem involved was the providing of a needle valve arranged to permit the use of exterior means for moving the needle valve back and forth.” In order to accomplish this the nozzle had to be curved, but this resulted in a reactive force tending strongly to turn the nozzle “To overcome this tendency, Doyle conceived the idea of **curving** the nozzle so as to place the axis in the plane of the nozzle’s sinuosity.”



Infringement was not denied; but the defense alleged non-invention, just as in the case at bar. Judge Van Fleet said with regard to the contention that the invention did not represent a true combination (532):

“It is well established you **cannot construe** a patent for a combination, such as this, **with reference to novelty as to any distinct separate feature**; for that purpose **the device is to be judged as a unit, and it is to be determined from its unitary action** whether it is a valuable combination or whether a mere aggregation. **You cannot take it piece meal** and finding that its various elements have been anticipated in different devices of the prior art, none of which, however, cover **all** of the elements which are to be found in the combination, and thereby successfully sustain a defense of anticipation. You must find **all** the elements of the combination **or their equivalents** in some particular device which is claimed to be an anticipation.”

## CONCLUSION

The Appellee has raised the usual defense interposed by defendants in patent infringement suits, namely: that the combination described in the claim is one which would suggest itself to a person skilled in the art and thus does not constitute invention. This defense is raised against

the presumptions of validity, novelty, utility and invention, which are established by the introduction in evidence of Appellant's patent. Further presumptions arise from the evidence of this case of commercial success, the satisfaction of a long felt want, unsuccessful efforts by others to meet the apparent need, exact imitation by Appellee, and the fact that a series of experiments was required before Appellee could arrive at the same conclusion reached by the patentee, even after Appellee was apprised of the solution of this problem, but had forgotten such solution.

THE APPELLEE HAS NOT CITED A SINGLE EXAMPLE OF THE PRIOR ART SHOWING THE COMBINATION, BUT HAS CITED PATENTS SHOWING THE INDIVIDUAL ELEMENTS SEPARATE AND DISTINCT FROM EACH OTHER.

A pertinent case involving similar defenses is **Buck v. Namm**, 22 F. (2d) 693, 696, a part of the opinion being as follows:

“Anticipation of an invention may not be found in gathering together separate and distinct prior patents, covering single elements in a combination, and then arguing that, although the new result of a combination discovered, does not appear in any such patent, nevertheless a skilled mechanic could easily discover from such patent the said new result or function on which a patent has been granted.

“I need not go into the question of equivalents, for the defendant’s box is a **copy of plaintiff’s disclosure**. The difficulty experienced by Delaney in the Patent Office, and its result in a patent, should not be lost sight of; nor should the immediate **imitation and adoption** by a large paper box manufacturer, and successful sales of the new box, be disregarded.”

Although it is necessary for a Court to determine the facts with regard to each patent and to base its opinion as to invention upon all of the facts in the prior art as adduced by the testimony, the several tests for invention commonly made with respect to said prior art, are succinctly pointed out in an opinion written by Circuit Judge L. Hand, in the Circuit Court of Appeals in the case of **R. Hoe, Inc., v. Goss Printing Press Co.**, 30 F. (2d) 271, 274:

“The more troublesome question is whether the mere combination of Gally with Scott did not require invention, assuming that, once the idea suggested itself, the rest was simple. As is often the case, the notion of uniting two mechanical means may require more originality than its subsequent execution, and in all such cases we are without objective tests. *Kirsch v. Mersereau Co.*, 6 F. (2d) 793 (C. C. A. 2). The only reliable evidence is from the history of the art. *White v. Morton*, 20 F. (2d) 311 (C. C. A. 2): how long it had to

wait for the supposed invention, what efforts had been made before, how long the need had existed, how successful was the answer.”

THE FOUR TESTS SUGGESTED FOR INVENTION THUS ARE: (1) THE LENGTH OF TIME THE ART HAD TO WAIT FOR THE INVENTION; (2) WHAT EFFORTS WERE MADE PREVIOUS TO SAID INVENTION; (3) HOW LONG THE NEED HAD EXISTED FOR SAID INVENTION; AND (4) HOW SUCCESSFUL WAS THE ANSWER.

On these questions the testimony given is unquestioned. The testimony of Charles F. Carlborg, a witness for plaintiffs, was that he had been a machinist since 1900 and that he formerly was vice-president of the defendant corporation and that special purpose tools had been made individually for each of the special purposes as long as he had been a machinist, or approximately thirty-two years. The witness J. J. Buhler corroborated Carlborg's testimony, except that his experience in the art was limited to the period from 1922 until the Eagle wrench was put out by plaintiffs in large quantities in 1928 (Test. p. 143).

The witness M. B. Pendleton, general manager of Plomb Tool Company, testified that there was a repeated demand from 1918 until the Eagle wrench was manufactured and sold by his Company for a “handle which was adapted to utilize standard sockets and during that period the plaintiff Com-

pany spent a good many hundred dollars attempting to devise some sort of jointed wrench which would be an improvement in the art and would meet the apparent demand." (T. 151) That he interviewed all the inventors who sought to interest his Company in a wrench designed to satisfy this need.

With regard to the second test as to what efforts have been made before witness Pendleton testified as above, witness Carlborg testified that each mechanic was required to purchase his wrenches and that it required an investment of several hundred dollars to have a complete set of wrenches and that mechanics devised their own tools to meet the individual needs and that mechanics generally spent "lots of time on designing wrenches" to cut down the number of wrenches and he personally spent some time on this problem (T. 138). Witness Buhler corroborated Carlborg's testimony on this point (T. 144).

The third test for invention as to the length of time the need has existed, was stated by Carlborg to be the entire length of time he was an automobile mechanic (T. 138), which was thirty-two years and the other two witnesses the length of time they had observed the problem, which was for a lesser period of time (T. 144, 151).

The fourth test concerns the commercial success of the device conceived by the patentee. This was testified to by all witnesses and is conceded

by the Appellee (T. 143). The commercial success of this wrench is uniform throughout the art, represented not only by sales made by Appellant Plomb Tool Company, but by the Appellee as well.

The Eagle wrench thus meets **every** test for invention; it has attained outstanding commercial success; it was deliberately imitated by the Defendant-Appellee, whose tool designer unsuccessfully attempted to solve the problem. After the Eagle wrench was conceived and embodied in a commercially successful device, Appellee attempted to modify it but had to return to the exact form of the Eagle wrench. The Eagle wrench produces a new result, or rather several new results: it is inexpensive, has greater utility, is more simple, strong, compact and sturdy. The trade has recognized the marked superiority of the Eagle wrench by abandoning substantially all of the previous tools. The Edmands wrench, cited as an equivalent by Defendant-Appellee, is a mere paper patent, too expensive to manufacture and too unhandy to operate.

The facts in this case are similar in many respects to those involved in the Alemite grease gun cases, the patent therein involving the automobile trade, in which the various defendants therein contended that the change from a grease cup to a grease gun with fittings, screw fitted in place, was obvious.

District Judge Anderson, in **Lunati v. Orgill Bros.** (Memo. Opinion Eq. 6666, West. Dist. of Tenn.), in finding patentable novelty in the elevator type turntables for greasing automobiles, cited the simplicity of the Alemite grease gun fittings [ *Lyman Mfg. Co. v. Bassick*, 18 Fed. (2d) 29 (C. C. A.) ] as a classic example of a simple combination:

“After all, most machines are based on very well known mechanical laws and their operation and principle are very obvious indeed, once some inventor has put them into successful operation.

“Probably the children of the cavemen played with squirt guns. Bayonet pin fittings are as old as bayonets. But a squirt gun with a slight suction device, fastened to an opening with a bayonet pin fitting, for the purpose of greasing the machinery of an automobile, has been with great unanimity held a patentable combination. The best tribute to the Lunati machine is the slavish imitation of it by the device sold by defendant.”

A case more in point with the facts in **Kurtz v. Belle Hat Lining Co.** (*supra*) than the present one would be difficult to conceive and thus the concluding paragraphs of the Court's opinion in that case (Brief, pp 60-61), are particularly pertinent and

bear repetition:

“Patentability has often been found ‘in discovering what is the difficulty with an existing structure’ and correcting the same, even though ‘the means’ are old and their mere ‘adaptation to the new purposes involves no patentable novelty.’ *Miehle, etc., Co. v. Whitlock*, 223 Fed. 647, 650, 139 C. C. A. 201. Hindsight, or wisdom after the fact, has always been looked upon with disfavor; e.g., *Faries Co. v. Brown*, 121 Fed. 547, 550, 57 C. C. A. 609.

“(4) If we viewed this hat lining, or any hat lining, in the light of our own experience, it would appear trivial and unworthy the dignity of patent protection; but, looking at it through the evidence and (we hope) with the eyes of the hat lining trade, this patent represents a large and successful business. It is in the minds of all those who deal in hat linings, of the utmost importance. No one ever made a lining of such simplicity, cheapness, and general adaptability as has Kurtz, and he has done it by mechanical means of winning simplicity, to all of which defendant has testified by deliberately imitating Kurtz’s product and engaging in expensive litigation to defend the imitation.

“We are of opinion upon this record that Kurtz’s hat lining is novel, useful, and displays patentable invention.”



In this case (1) the deliberate imitation, (2) the continued manufacture and sale of the Eagle wrench by P. & C. Hand Forged Tool Company, Appellee here, after attempting to improve or modify said wrench, (3) the engaging in expensive litigation to defend the imitation, (4) the failure to adopt the Edmands type wrench available to any member of the public without infringement of the expired patent, and (5) the fact that its infringing manufacture and sale constitutes one-half of its business, indicates what Appellee actually thinks of the Eagle wrench. Said attitude refutes the testimony of Appellee's witness that the Edmands' wrench is a more desirable wrench; that it is cheaper, more efficient and "will do anything the Eagle wrench will do." When Appellee entered the field of selling wrenches of this character, the Edmands' patent had expired and the wrench disclosed therein was public property. The Eagle wrench was the property of the Appellants herein. Appellee deliberately chose slavishly to imitate the Eagle wrench in all of its details, including color and external detailed appearance.

It is submitted that the art is never advanced by the implied sanctioning of deliberate piracy, where the only reason advanced for said taking is that **anyone could have done as well if he had thought of doing it.**

It is submitted that upon the evidence in this case the decree of the lower Court is erroneous and should be reversed.

Respectfully submitted,

CAKE & CAKE,  
JAUREGUY & TOOZE and  
W. ELMER RAMSEY,  
Solicitors for Appellants.